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RECORD OF ORAL HEARING  
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte BRIAN L. GIBSON  
and FRED DURRENBERGER

Appeal 2009-002988  
Application 10/766,430  
Technology Center 1700

Oral Hearing Held: June 23, 2009

Before CHARLES F. WARREN, CATHERINE Q. TIMM, and  
JEFFREY T. SMITH, Administrative Patent Judges

ON BEHALF OF THE APPELLANTS:

JOSEPH POSILLICO, ESQUIRE  
Fox Rothschild  
1101 Market Street  
Suite 2600  
Philadelphia, Pennsylvania 19107

**ALSO PRESENT:**

JIMMIE JOHNSON, Fox Rothschild  
CARRIE BEATUS, Honeywell

1           The above-entitled matter came on for hearing on Tuesday,  
2   June 23, 2009, at 10:10 a.m. at the U.S. Patent and Trademark Office, 600  
3   Dulany Street, Alexandria, Virginia, before Leanne M. Krivonak, Notary  
4   Number 180129, Notary Public.

5           THE CLERK: Calendar Number 52, Appeal Number  
6   2009-002988. Mr. Posillico.

7           JUDGE WARREN: All right. Mr. Posillico.

8           MR. POSILLICO: Good morning.

9           JUDGE WARREN: I believe, I'm sorry.

10          Would you please introduce your guests, sir.

11          MR. POSILLICO: Yes, good morning. Thank you.

12          What I would like to do is start out --

13          JUDGE WARREN: Sir, could you introduce your guests?

14          MR. POSILLICO: Oh, yes, I'm sorry.

15          I have with me Mr. Jimmie Johnson, also from Fox Rothschild  
16   and Ms. Carrie Beatus from Honeywell.

17          JUDGE WARREN: Good morning.

18          As you know, sir, you have 20 minutes. You may start when  
19   ready.

20          MR. POSILLICO: Yes. May I proceed?

21          JUDGE WARREN: Please.

22          MR. POSILLICO: First, I would like to thank the Board for  
23   their time; second, we are going to rely primarily on the briefs and so I  
24   would like to try touch on the most important that I can elucidate a little bit  
25   that are in the brief, but I can expand on.

1           What I would like to start on with is identify what we're not  
2     claiming in this case. This case is one in which we are not claiming  
3     compounds and we're not claiming compositions. And one of the reasons I  
4     want to point that out is because I think it helps to highlight what some of  
5     the flaws are in the Examiner's rejections.

6           In some ways the Examiner's rejections are looking at the  
7     claims as if they were -- we were trying to claim the compounds that are  
8     identified in the claim, but we are not. What we are claiming is a process, an  
9     extrusion process that has two steps in it. One is to provide a specific  
10    extrudable composition that compromises an extrudable resin, plus a  
11    compound or a collection of compounds, a mixture of compounds having a  
12    specific structure.

13          That specific structure is required that at least 50 percent of the  
14    compounds that are used have an octa- substituted carboxylic acid ester  
15    structure.

16          The Examiner has cited the Kaynaco reference as anticipating  
17    the claim. The problem with the rejection is that the Kaynaco references  
18    never mentions any particular type of sucrose ester. I should say it actually  
19    mentions two types specifically. It mentions monosubstituted esters and dye  
20    substituted esters. And other than that it's just simply generically indicates  
21    the use of sucrose alkyl esters.

22          I think one of the problems -- so on its face there is no explicit  
23    description of a compound having a structure that is required by our claim.

24          Again, that structure requires that there is a carboxylic acid  
25    ester at each of the eight possible substitution sites on the sucrose.

1           The Examiner has taken the position that that never -- that that  
2 reference never left anticipates the claim and the -- I gather the Examiner's  
3 position is that that the compound that we're specifically requiring is  
4 somehow inherent in the disclosure. And I think the Examiner's position is  
5 that that flows because there is only a small number of species within the  
6 generic term of sucrose alkyl ester and here is where there is, I think, a  
7 substantial disagreement.

8           In our Brief we identified that there are eight subgeneric classes  
9 of compounds within the term sucrose alkyl ester.

10           The Examiner had taken the position that there are eight  
11 species, I gather, or eight compounds. So from a factual standpoint, a  
12 technical standpoint, there is a very large disagreement.

13           Within the designation of sucrose alkyl ester there are literally  
14 thousands and thousands, almost an incalculable number of compounds that  
15 fall within that group.

16           By way of example, there are at least eight mono substituted  
17 esters, depending upon the position of the ester, and you can multiply that  
18 out almost geometrically.

19           So the Examiner has taken the position that there is only three  
20 species which I think the position is wrong and in fact there are thousands.

21           The Examiner has also missed the fact, I think, that we are  
22 specifically claiming a carboxylic acid ester. There are two of those types of  
23 esters mentioned in Kaynaco, but the generic disclosure is not limited to  
24 that. Within the description of a sucrose alkyl ester you can have a  
25 phosphate ester which then multiplies the number of potential compounds by  
26 even more thousands.

1               So for the Examiner to take the position that Kaynaco  
2 inherently discloses the compound that we require to be present in at least 50  
3 percent of those molecules is just factually wrong.

4               Now the Examiner has cited this website for the proposition  
5 and it's actually not very clear why the Examiner has cited that website and,  
6 in fact, whether the citation of that website is proper in an anticipation  
7 rejection.

8               Anticipation should find all of the claimed subject matter in a  
9 single reference, but in this case the Examiner is bringing in another  
10 reference which, by my understanding of the law would be proper to explain  
11 how a person skilled in the art would understand that that reference should  
12 be read. But I don't see that being the case here with this page from the  
13 website.

14              What the Examiner has said is that the page from the  
15 website -- he's citing that page from the website for the proposition that the  
16 sucrose alkyl ester that's disclosed in Kaynaco is identical to what we're  
17 claiming and so that to me is different than to simply saying this is how a  
18 person skilled in the art would understand a reference. He is bringing in  
19 another reference which, by my understanding the case law is improper  
20 under an anticipation of rejection.

21              JUDGE WARREN: You can in an anticipation rejection can,  
22 of course, bring in a reference to explain a fact and the reference relied upon,  
23 I believe.

24              Correct?

25              MR. POSILLICO: I'm sorry. I'm --

1 JUDGE WARREN: In an anticipation rejection you can bring  
2 in a reference to show how one of ordinary-skilled in the art would interpret  
3 the reference relied on.

4 MR. POSILLICO: That's correct.

5 JUDGE WARREN: And you're saying that doesn't happen  
6 here?

7 MR. POSILLICO: That doesn't really happen here.

8 In fact, it's -- do you have another question?

9 JUDGE WARREN: So the product literature that the Examiner  
10 cites does not refer to a trade name in the patent -- in the Kaynaco patent?

11 MR. POSILLICO: Not that I'm aware of.

12 It doesn't -- there is no -- there is nothing that the Examiner has  
13 cited to or that I'm aware of that would link specifically the term sucrose  
14 alkyl ester to this website page indicating that that term means this  
15 compound.

16 In fact, --

17 JUDGE WARREN: Well, is he using it just to give an example  
18 of a structure?

19 MR. POSILLICO: Well, what the Examiner says in his  
20 rejection and his Answer is he's using it to show that the sucrose alkyl ester  
21 of Kaynaco, and that's the Examiner's words, is identical to the compound  
22 that we're claiming.

23 So to me -- so, I have two points on that. Number one, I think  
24 that's legally improper because that is not, as you said, Your Honor, using  
25 the second item simply to explain how a person skilled in the art would  
26 understand it, he's trying to use it to show some kind of identity of structure.

1 But the second problem is --

2 JUDGE WARREN: Well, if you're correct, Counselor, that the  
3 sucrose alkyl esters of the reference include the compounds such as those  
4 described within a website article here, why would there be a problem of the  
5 Examiner using the website article to give a demonstration of the structure  
6 of the sucrose monoester?

7 MR. POSILLICO: Well, if there was an issue about what the  
8 structure would be, that perhaps would be the case, but he's not using it as an  
9 example. He's using that website to take the position that what is disclosed  
10 in Kaynaco is identical to what we're claiming and so it's not explaining the  
11 term.

12 We acknowledge that the term, sucrose alkyl ester, includes a  
13 huge number of compounds, including within that broad genus the  
14 compound that we've selected to be present in at least 50 percent. But the  
15 case law is very clear, a simple mentioning of a genus is not a disclosure of  
16 every single species in the genus.

17 So what I think the Examiner has done is he using this citation  
18 to the website to kind of get around that problem. Actually his citation of  
19 that document actually supports our position and it doesn't help his. And  
20 that's because the structure that's shown in that document is not a structure  
21 within the structure of our claims.

22 There are two things that are important about -- again, if you  
23 were to assume that it's relevant for any purpose and we want to look at its  
24 teaching, that structure shown in the website has one location substituted  
25 with stearic acid ester, but then there are two other locations which appear to



1 be substituted with methoxy groups and our structure would not permit, does  
2 not encompass that kind of a structure.

3 So the Examiner is saying that this is so inherent all I would  
4 have to do is go to this website to show the identical structure, but he's  
5 actually proving our point and that is it's not inherent, the term sucrose alkyl  
6 ester is so broad to encompass thousands of compounds, even ones that are  
7 not within the scope of our claims.

8 The other point is that same document has a statement in there  
9 which indicates and I can read it for you, but it indicates that they  
10 provide -- sugar esters as they refer to them -- with HLB values from 1 to 16  
11 and then it provides a chart.

12 And if you look at that chart, there is no sugar ester as recited  
13 on that website that has anything more than 10 percent octa ester in it. The  
14 one that has the most concentration of octa ester is the one that is identified  
15 next to the HLB value of 1 and the percentage of octa ester is barely visible  
16 all the way to the right of the chart which is between the 90 and the 100  
17 which indicates that it's less than 10 percent of octa ester.

18 So there's -- and the amount of octa ester goes down from there.  
19 So according to this -- the website that the Examiner has cited every single  
20 compound or combination of compounds that are described in this website  
21 would not meet our claims. And again, there is an infinite number of those  
22 because these are just -- they're bracketing of the range.

23 So as you go from 1 to 3 to 7 to 11 to 16, all of those have 10  
24 percent or less of octa ester compounds; whereas, in contrast our claims  
25 require at least 50 percent of octa ester substituted carbocyclic acid  
26 compounds and the reason that claim says that is because we have

1 discovered that there are unexpected results with respect to the performance  
2 in this process on the extruded product and extrusion process when you use  
3 compounds or combination of compounds where you have that minimum  
4 amount of the octa substituted carboxylic acid esters.

5 One other point I would make, too, is our claim requires that  
6 the carbocyclic acid esters have from eight -- in a broad claim eight to 40  
7 carbon atoms and then there are some narrower claims where we say 12 to  
8 26.

9 The Examiner has again said that anticipated because there is a  
10 mention of fatty acid. Again, it's the similar kind of problem. Fatty acid is a  
11 very general term, a broad term, which by my understanding of the term can  
12 have as little as all four, five or six carbons or -- perhaps at least on the low  
13 side is outside the scope of that range. And that brings in again another  
14 whole variability to what would be required here for Kaynaco to be an  
15 anticipatory reference.

16 This disclosure is simply generic and there's thousands of  
17 potential compounds or species within that -- And therefore, the anticipation  
18 of rejection can't stand and once we establish that, we have strong evidence  
19 of non obviousness because of the unexpected results.

20 And that's what I would like to emphasize. If there are any  
21 other questions, I would be happy to try to answer them.

22 JUDGE WARREN: No further questions.

23 MR. POSILLICO: Thank you.

24 JUDGE WARREN: Thank you very much.

25 Whereupon, at approximately 10:25 a.m., the proceedings were  
26 concluded.